REMARKS

The present amendment is in response to the Office Action dated May 18, 2007, where the Examiner has maintained a rejection of claims 36-62. In the present amendment, claims 36, 38, and 56 have been amended and claim 63 is new. Accordingly, claims 36-63 are pending in the present application with claims 36, 38, 45, 56, and 63 being the independent claims. Reconsideration and allowance of pending claims 36-63 in view of the amendments and the following remarks are respectfully requested.

A. Rejection of Claims 36-44 Under 35 U.S.C. 103

Claims 36-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,198,390 issued to Schlager ("Schlager") in view of US Patent Number 6,091,956 issued to Hollenberg ("Hollenberg"), and further in view of US Patent Application Publication No. 2002/0087401 issued to Leapman ("Leapman").

With regard to independent claims 36 and 38, the Examiner states that Schlager teaches the limitations of claims 36 and 38, but does not teach "the user storing a specific activity associated with the at least one target location" and "outputting an indication of the specific activity associated with the at least one target location." The Examiner further states that Hollenberg teaches these limitations. The Examiner further states that neither Schlager nor Hollenberg teach "the user storing a specific activity associated with at least one target location in the memory before entering the target range." The Examiner further states that Leapman teaches this limitation. The Examiner states that the combination of Schlager, Hollenberg, and Leapman makes the claims obvious. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a prima facie case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion

to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Combine

The subject matter of the amended claims is directed to location-based responses to a user utilizing a wireless communications device, in which the user stores a specific activity and a customized indication associated with the specific activity. The specific activity and the indication are associated with the at least one target location and stored in the memory before the user enters the target area or becomes proximate to the target location. When the user becomes proximate to one of the target locations, the wireless communication device outputs from the memory the indication of the specific activity. (See, independent claims 36 and 38.)

The indication can be custom tailored to suit the needs of the individual. For example, if the target location is a specific store and the specific activity is to buy a certain item, the indication can be a text message that flashes "buy bread." Similarly, the indication can be a customized text message that is displayed on the screen once the user is within the target range. (See, page 13, lines 15-20, for example).

The Schlager reference addresses the use of a separation distance between a device and a target, which can be used for example to sound an alarm. (See, Schlager, Column 15, Lines 1-16.) The Hollenberg reference operates by receiving information via an antenna and conveying the information (such as an advertising message) to a user display. (See, Hollenberg, Column 16, Lines 11-24.) The Leapman reference describes a filtering mechanism that is compared to incoming advertisements associated with particular locations and displays the advertisement if the filter lets the advertisement through. (See, Leapman, Figure 4).

Schlager fails to disclose any suggestion or motivation for a user to store a specific activity associated with the at least one target location or an indication of the specific activity in a memory, before a user enters a target range, which is included in the independent claims 36 and 38. Merely sounding an alarm, as in Schlager, is not a "specific activity" from a "user" such as identifying a grocery store as a target location, and establishing an output response or "indication" like "picking up a loaf of bread at the grocery store." Furthermore, Schlager is exactly opposite the claims because the

trigger in Schlager is when the device moves away from a target not when a device moves into a target region.

In addition, Hollenberg fails to cure the basic deficiencies of Schlager. In Hollenberg, displaying an advertisement when a user enters a certain area or enters a store is still not a "specific activity" from a "user." Even assuming arguendo that an advertisement popping up on a user display at a certain location was a "specific activity," Hollenberg fails to teach storing of the "indication" of the specific activity in the memory of the wireless communication device before the user became proximate to the store because the advertisement is downloaded to the device and not pre-stored as a customized indication by the user before the device is operated.

By Hollenberg's very nature, each advertisement must be received via an antenna as the user enters an area proximate to a store where the advertisement would become pertinent. (See, Column 16, Lines 11-24.) Modifying Hollenberg such that all advertisements are pre-stored in the memory is nowhere disclosed or even suggested because such a modification would create too much data to be stored in any individual handheld device due to the limited memory resources of such a device. For that reason, receiving the advertisements via an antenna on the fly, as disclosed by Hollenberg, teaches away from the proposed combination and, as such, there is no suggestion or motivation to combine Schlager with Hollenberg.

In addition, Leapman fails to cure the basic deficiencies of Schlager and Hollenberg. Leapman merely adds a filtering mechanism to the combination of the prior two references. Even if the filter is pre-programmed, the "indication" presently claimed such as "buy bread" or another pre-programmed text message to be displayed, for example, is not suggested by Leapman because Leapman merely downloads an advertisement and if the advertisement is such that the filter lets it through, it is displayed on the screen.

For example, in Leapman the user might have a "buy skim milk" entry in a to do list. This entry might result in an advertisement for skim milk being downloaded and displayed if a user drives past a grocery store. (See, Leapman, Paragraph 32). In no way can this advertisement be pre-programmed in the memory since it is downloaded on the fly and let through only if the filter allows it. Even if the advertisement itself is

interpreted to be an "indication" of a "specific activity," Leapman teaches away from the present claims because it is impossible to program the advertisement into the memory before becoming proximate to the grocery store, because the advertisement is "broadcast" as the user drives by the store. (See, Leapman, Paragraph 32).

As such, the "buy skim milk" entry in the to-do list of Leapman results in "acceptance data" that is used as a filter to accept an appropriate advertisement. The advertisement, if used to indicate something to a user, is not pre-programmed into memory before the user enters the target area. Instead, it is broadcast by an advertiser and filtered into the device after the user is in the target area. What is displayed is not "buy skim milk" but instead the broadcast advertisement. Therefore, Leapman suffers from the same deficiencies as Hollenberg and the proposed combination does not create a motivation to combine.

2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited the prior art reference points to the reasonable expectation of success in the present claims, which is the second requirement of the obviousness analysis. For example, Schlager does not teach a specific activity associated with a target location. (See, Page 3 of the Office Action.)

Applicant asserts that Hollenberg does not teach this limitation either. However, even if Hollenberg did teach this limitation, one could not reasonably expect to succeed by combining the two references because Hollenberg requires that the advertisement be received via an antenna after the user becomes proximate to the target range or target area. (See, Column 16, Lines 11-24.) Even if Schlager could be combined with Hollenberg, the user specific activities that are presently claimed would have to be transmitted to the wireless device after the user entered the target range. This would waste bandwidth, it would increase latency, and it is contrary to the wording of the current claims.

Similarly, it would be impossible to put all of the possible advertisements into the memory of a wireless device in advance of entering the target range because there are too many advertisements, they change too often, and the wireless device has limited resources. In fact, the present application specifically avoids the drawbacks that would

occur if the user specific activities were not put into memory beforehand. These are the very same drawbacks that would hinder the expectation of success of the proposed combination, if it were possible to combine Schlager with Hollenberg.

Moreover, a filter as in Leapman does not make the expectation of success any more likely. By its nature, the filter operates on data that is downloaded or "broadcast" as the user enters the target area. (See, Leapman, Paragraph 32) For that reason, any "indication" of a specific activity cannot be pre-programmed because it is uncertain if it will even be displayed on the screen. The device in Leapman would need to have every potential advertisement pre-programmed into memory before using the device for such an "indication" to be pre-stored before entering the target area.

Such a pre-programming is not possible on the limited memory of a portable device. As such, the addition of Leapman does not make the proposed combination succeed since it cannot be anticipated what advertisements will be broadcast before entering the target area. Similarly, the "acceptance data" used as a filter, even though it is pre-programmed does not operate as an indication of a specific activity and the acceptance data is never displayed to the user. The acceptance data merely filters out unneeded advertisements that are broadcast to the device. Therefore, the proposed combination does not have a reasonable expectation of succeeding in performing present claims 36 and 38.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. For example, the present claims 36 and 38 (the wording is slightly different for each claim) provide that the user stores a "specific activity" associated with the at least one target location and "an indication" of the specific activity in the memory "before approaching the target range."

Schlager discloses self-locating remote monitoring systems in which a base station receives information from the remote device to determine appropriate actions, such as sounding alarms (See, Column 7, Lines 5-10.) For example, in FIG. 16, geographical regions and boundaries are stored in the storage circuits 410, and serve as one input to the comparator 412 (FIG. 13). The comparator 412 also receives the location output 432 from the navigational receiver 406. The comparator 412 compares

the location of the remote unit 402 with the defined geographical region and defines a relationship between the location and the defined region, which is expressed as a positional status. For the first example, the location is "within a defined geographical region" or "outside the defined geographical region." The comparator 412 defines a positional status that "the location of the remote unit relative to the defined region is acceptable" or "the location of the remote unit relative to the defined region is not acceptable." This positional status is then transmitted to the base station 404 and will or will not result in activation of an alarm 430.

For a next example, three successive locations 498, 500 and 502 are an "acceptable", a "warning" or a "prohibited" subregion in Schlager. In another embodiment, no enforcement or warning are given by the remote unit 402. Instead, as when used to monitor the movements of children or elderly patients, the positional status is transmitted to the base station 404 for a determination of a positional status.

Regardless of the nature of the subregions in Schlager, the teaching is to, for example, sound an alarm or not sound an alarm. Such a sounding or not sounding of an alarm is not a "specific activity" defined by a user. It is merely an alarm that is not specific, not changeable, and not defined by the user.

Hollenberg, on the other hand, receives information via an antenna and conveys the information (such as an advertising message) to a user display. (See, Column 16, Lines 11-24). The purpose of the antenna in Hollenberg is to receive input data when the user enters the target range. As such, Hollenberg does not store the advertisement it provides "before the user becomes proximate to the target range."

Likewise, Leapman stores acceptance data in memory, but the acceptance data is a filter for potential advertisements that may not be useful. The filter is an "indication" of nothing and is never retrieved and displayed to the user when the device is proximate to a target area. Even if the Examiner interprets the Leapman reference to store "information entered in the memory before the occurrence of an event," the present claims require an "indication of a specific activity." Since the acceptance data is never shown to the user and merely filters advertisements (the advertisements being broadcast only when the user enters the target area), Leapman does not include the

present limitation of an "indication" that is pre-programmed into memory prior to entering the target area.

Since the combination of references does not include all the limitations of claims 36-44, the Applicant requests that the rejection be withdrawn.

4. Effect of KSR

After the recent Supreme Court decision in the KSR case, although it is clear that the above analysis using the Federal Circuit's teaching-suggestion-motivation test is not the only way to approach the obviousness inquiry, it remains a useful tool in the obviousness inquiry. However, even if an alternative tool is employed as part of the obviousness inquiry, it is clear from KSR that any combination of references in an obviousness rejection must provide reasonable inferences that are based on substantial evidence in the record. Here, no such substantial evidence has been identified and therefore even after KSR, Applicant asserts that the pending claims are not obvious in view of the prior art of record.

B. Rejection of Claims 45-49 and 53-62 Under 35 U.S.C. 102

Claims 45-49 and 53-62 are rejected as anticipated under 35 U.S.C. 102(b) based on Schlager. Applicant has amended independent claims 45 and 56. Applicant asserts that Schlager does not teach, suggest, or describe at least "a target message" being entered into the memory "before the wireless device is proximate" to a range area (claim 45) and storing "an indication of the specific activity" associated with a first target location in the memory, wherein the indication is stored "before entering the first target area." (claim 56).

Schlager teaches self-locating remote monitoring systems in which a base station receives information from a remote device to determine its location and sound an alarm. (See, Column 7, Lines 5-10.) For example, in FIG. 16, geographical regions and boundaries are stored in the storage circuits 410, and serve as one input to the comparator 412 (FIG. 13). The comparator 412 also receives the location output 432 from the navigational receiver 406. The comparator 412 compares the location of the remote unit 402 with the defined geographical region and defines a relationship between the location and the defined region, which is expressed as a positional status.

This positional status is then transmitted to the base station 404 and will or will not result in activation of an alarm 430.

Activating an alarm based on a positional status is not a "target message" that is input by a user as claimed by Applicant. That is, a warning as taught by Schlager does not prompt the user to perform a user-stored specific activity as claimed by Applicant nor is it input before the user enters the target area. Therefore, Schlager clearly does not disclose the claims.

As such, Applicant asserts that Schlager does not anticipate the independent claims 45 and 56. Additionally, Applicant respectfully asserts that Schlager does not disclose each and every element of the dependent claims 46-49, 53-55, and 57-62). Thus, Applicant respectfully requests that the Examiner issue a notice of allowance for the pending independent claims 45 and 56 and their respective dependent claims 46-49, 53-55, and 57-62.

C. Rejection of Claims 50-52 Under 35 U.S.C. 103

In the Office Action, claims 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlager. With regard to claim 50, the Examiner states that Schlager teaches the limitations of claims 50, but does not teach that the wireless communications device is a laptop, a pager, or a PDA. The Examiner further states that such limitations are obvious based on Schlager. With regard to claim 52, the Examiner states that Schlager teaches the limitations of claims 52, but does not teach that target range area is two-dimensional or three-dimensional space. The Examiner further states that such limitations are obvious based on Schlager.

The arguments presented with respect to the obviousness rejection of independent claims 36 and 38 also apply to independent claim 45, upon which the currently rejected claims 50 and 52 depend. The subject matter of presently claimed in claim 45 is for location-based responses to a user utilizing a wireless communications device, in which the user stores a specific activity or a "target message" associated with the at least one target location in the memory before the user enters or becomes proximate to the range area associated with the target location.

The Schlager reference addresses the use of a separation distance between a device and a target, which can be used for example to sound an alarm. (See, Column

15, Lines 1-16). Schlager fails to create a suggestion or a motivation for a user to store a target message associated with the at least one target location in a memory, "before the wireless device is proximate to the range area," which is included in the independent claims 45.

Moreover, the Examiner has not demonstrated that the modification of the cited reference points to the reasonable expectation of success in the present claims, which is the second requirement of the obviousness analysis. For example, Schlager does not teach a user defined, target message associated with a target range, and the Examiner does not demonstrate that Schlager could be successfully modified to perform that limitation with respect to claim 45. As such, there is also no reasonable expectation of success to perform the limitation on a laptop, PDA, or pager as in claim 50 or in 2-D or 3-D space as in claim 52.

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. For example, the present claim 45 provides that the user stores a "target message" associated with the at least one target location in the memory before approaching a range area. Schlager discloses self-locating remote monitoring systems in which a base station receives information from the remote device to determine appropriate actions, such as sounding alarms (See, Column 7, Lines 5-10.)

In Schlager, the teaching is to sound an alarm or not sound an alarm. Such a sounding or not sounding of an alarm is not a "target message" defined by a user. It is merely an alarm that is not specific, not changeable, and not set by the user. As such, performing the above limitation on a laptop, PDA, or pager as in claim 50 or in 2-D or 3-D space as in claim 52 is also not taught by Schlager. Since the combination of references does not include all the limitations of claims 50-52, the Applicant requests that the rejection be withdrawn.

D. New Claim 63

New claim 63 is an independent claim. New claim 63 includes a number of steps involved with pre-programming the wireless communication device with a target location, a target message and a geographic and temporal range area. New claim 63

does not add new matter and is fully supported by the specification. Applicant respectfully requests that a notice of allowance be issued with respect to new claim 63.

E. Conclusion

For all the foregoing reasons, an early allowance of claims 36-55 pending in the present application is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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/George W. Luckhardt/
George W. Luckhardt
Reg. No. 50,519

George W. Luckhardt
Kyocera Wireless Corp.
Attn: Patent Department
P.O. Box 928289
San Diego, California 92192-8289
Tel: (858) 882-2593
Fax: (858) 882-2485